

REMARKS

At the time of the 9/2/08 Office Action, claims 1, 2, 5, 9, 10, 13-19 and 25-29 were pending in the instant application and claim 6 was withdrawn from consideration. Upon entry of Applicants' amendments to claims 1 and 2 and cancellation of claim 13, the instant application will have pending claims 1-2, 5, 9-10, 14-19 and 25-29 and claim 6 withdrawn from consideration. The amendments are fully supported in the specification and do not introduce new matter.

Petition To Revive Under 37 CFR 1.137(b)

Applicants acknowledge and thank the Office for the grant of its petition to revive the present application under 37 CFR 1.137(b).

Rejections Under 35 USC 112

Applicants acknowledge and thank the Examiner for withdrawal of the rejection under 35 USC 112 2nd paragraph.

Claim 1 is rejected under 35 USC 112 2nd paragraph as failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention in that radical 'B' is not found in the formulae of the claim. Applicants herein delete the definition of radical 'B' which was part of a group within the definition of radical 'A' which no longer appears in the claim.

Improper Markush Objection

Claims 1, 2, 5, 9, 10, 13-19 and 25-29 are objected to as being drawn to an improper Markush group. The examiner asserts that the compounds within the claims do not share a substantial structural feature disclosed as being essential to that utility as described in *In re Harnisch*, 206 USPQ 300. The Examiner further states that the groups possess widely different, physical and chemical properties and therefore are not considered functionally equivalent. Applicants respectfully traverse the objection.

A claim should not be rejected as claiming an "improper" Markush group unless the examiner can show that the subject matter of the claim lacks unity of invention. The instant claims are drawn to compounds of formula I which incorporates a substantial core structure, a tyrosine derivative linked to a substituted phenyl group. The core structure is essential to the utility common to the claimed compounds, that utility

being inhibition of alpha-4 integrins interacting with their ligands, such as MAdCAM and/or VCAM. The specification discloses approximately 400 discreet compounds within the claim scope which exhibit this inhibitory activity. The Examiner has provided no technical basis disputing this. Compounds included within the Markush group defined by formula I therefore: (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

The Examiner alleges that X₁, A and Y are improper Markush groups. However, where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression. MPEP 2173.05(h). As previously stated, the compounds share a substantial core structure, a tyrosine derivative in which X₁ modifies the tyrosine hydroxyl group, linked to a substituted phenyl group represented by A.

It is noted that grandparent application 09/669,779 was found to be drawn to proper Markush groups and was issued as US 6,469,047. The '047 patent claims compounds of formula III which differ from the presently claimed compounds of formula I merely by an ethylene moiety which constrains the tyrosine of the core structure. Groups X₁, Y and A are common to both formula I and formula III.

Rejections Under 35 USC 102

Applicants acknowledge and thank the Examiner for withdrawal of the rejection under 35 USC 102 based upon the Athena Neuroscience and McKillop references.

Claims 1, 2 and 14 stand rejected under 35 USC 102(b) as being anticipated by Veigl et al (reference U), in particular compounds in figure 1 at page 136 and compound 3 found on 138.

Applicants note that the compounds in figure 1 at page 136 of Veigl incorporate an R group that is defined to be a linker to a silica gel support. Compounds of the present invention as defined in the claims do not incorporate a silica gel support and therefore the claims do not read on these compounds. Nevertheless, Applicants herein amend the definition of radical 'A' in claims 1, 2, such that R₁ or R₂ is not hydrogen. Support for the amendment is found at page 18, lines 10-13 of the specification. Accordingly, the rejection is moot and withdrawal thereof is respectfully requested.

In view of Applicants' amendments and remarks presented herein, the claims are believed to be in condition for allowance and notice thereof is respectfully requested.

Respectfully submitted,
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